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04/15/91 By Roy C. Hopgood
(Date) Reg.No. 15,245



PATENTS/6083

91 JUL -2 MAIL RECEIVED
SPECIAL PROGRAM APR 22 91
EXAMINATION UNIT GROUP 330

Firm Name Hopgood, Calimaafde, et al.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No.: 4,718,418
Issued: January 12, 1988
Applicant: FRANCIS A. L'ESPERANCE, JR.
Serial No.: 916,646
Filed: October 8, 1986
Group: 335
Examiner: David Shay
For: APPARATUS FOR OPHTHALMOLOGICAL SURGERY

VERIFIED STATEMENT OF FACTS PERTAINING TO
PAYMENT OF FEES

The Commissioner of Patents and Trademarks
Washington, D. C. 20231

Attention: Karen O. Wood, Legal Technician
Special Program Examination Unit

Sir:

With the subjoined verifications of Drs. Francis A. L'Esperance, Jr. and William B. Telfair, and in response to the letter* under 37 C.F.R. 1.28(c)(2), from the Office of the Assistant Secretary and Commissioner of Patents and Trademarks, the following factual statement is made by the undersigned attorney of record in the above-captioned matter.

* The letter was undated but was received by our office February 19, 1991.

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04/15/91 By Roy C. Hopgood
(Date) Reg.No. 15,245

Firm Name Hopgood, Calimaafde, et al

1. I, Roy C. Hopgood, have been attorney of record on a series of patent applications relating to laser sculpture of the cornea, to effect in-vivo surgical correction of optical deficiencies in human eyes. The series of these cases commenced in 1983, when I was so engaged by Dr. Francis A. L'Esperance, Jr., a recognized pioneer in application of lasers to the human eye. The number of these applications multiplied, as Dr. L'Esperance, Jr. developed improvements to his original concepts; and in the period 1985 to 1988, there must have been about 20 applications under simultaneous prosecution. This figure of 20 is to be understood to include continuation applications, divisional applications, and C.I.P. applications. Most of these applications have now been reduced in number, in that their allowed claims have been collectively combined, where possible, resulting in patents numbered 4,665,913; 4,669,466; 4,718,418 (above-identified); 4,721,379; 4,729,372; 4,732,148; 4,770,172; 4,773,414; 4,798,204, in addition to patents such as Patent 4,903,695 wherein Dr. L'Esperance, Jr. is a co-inventor. All of these L'Esperance, Jr. cases were assigned to LRI L.P., a Delaware Limited Partnership.

2. In the course of my working solely for Dr. L'Esperance, Jr., a single individual inventor, he and others formed said LRI L.P. as the repository of patent rights pertaining to the corneal-sculpture inventions of Dr. L'Esperance, Jr.; also, and later, he and others formed a fledgling corporation, Taunton Technologies, Inc., operating under license from LRI L.P., for the purpose of developing instrumentation and negotiating FDA protocol arrangements in contemplation of use of Dr. L'Esperance, Jr.'s inventions in application to human patients. I have had no part in such arrangements, in that I have been extremely heavily committed to U.S. and foreign prosecution of Dr. L'Esperance, Jr.'s inventions.* Neither have I been involved in matters of subscription by others to support the development work at Taunton Technologies, Inc., or to support FDA negotiations and arrangements, or in the solicitation of monetary subscriptions by others, or in marketing negotiations in support of a burgeoning technology.

* Not to mention my on-going substantial commitments to other clients; these commitments were so burdensome that I transferred to another firm the responsibility for the handling, on behalf of Taunton Technologies and Dr. L'Esperance, Jr., of Interference proceedings brought by others against four of Dr. L'Esperance, Jr.'s patents.

3. Approximately 20 months ago, and before commencing work to determine fee deficiencies in the present case and in other L'Esperance, Jr./Taunton Technologies cases, I became aware, from Interference counsel, that Taunton Technologies, Inc. had entered into a Marketing Agreement dated April 21, 1987, involving license granted to separate corporations, to "market, use and sell" the patented subject matter, and that this Agreement had automatically eliminated the small-entity status of Taunton Technologies, Inc. and of LRI L.P.; as of April 21, 1987, LRI L.P. was assignee of record in the present case. Failure to make subsequent fee payments on a large-entity basis is attributable to an error which occurred in good faith and without fraudulent intent.

4. The checking of fee deficiencies after April 21, 1987, required concentrated review of many files, for all then-pending cases; the first opportunity to expend straight time on review and collation of fee-correction data was during my absence of three weeks abroad in June 1990. I assigned my secretary to the task, and our fee-correction letter dated July 9, 1990 in the present case is but one of a much larger number of similar letters bearing the same date and accounting for fees in other applicable L'Esperance, Jr. cases, inasmuch as it was my decision to tackle all of these cases as a single project, rather than piecemeal, one case at a time.

5. It is noted from the undated letter (received February 19, 1991) to which the present Verified Statement responds, that the issue fee paid in the above-identified patent was deficient to the extent of \$60.00, but that a refund of \$467.00 (\$807.00 paid, less \$340.00 owed) may be requested.

6. The request is therefore being made, by separate letter to the Finance Branch, for a refund in the amount of \$467.00, and said request to the Finance Branch is accompanied by a copy of the said undated letter from the Office of the Assistant Secretary and Commissioner of Patents and Trademarks.

7. This Verified Statement of Facts is believed to be fully responsive to the said undated letter from the Office of the Assistant Secretary and Commissioner of Patents and Trademarks. And it is requested that this Verified Statement be accepted and that the Finance Branch be so informed, so as to enable prompt refund of the \$467.00 overpayment.

Respectfully submitted,
By Roy C. Hopgood
Roy C. Hopgood
Reg. No. 15,245
Attorney for Applicant/Assignee
212-986-2480

VERIFICATION BY DR. FRANCIS A. L'ESPERANCE, JR.

STATE OF NEW YORK)
) ss:
COUNTY OF NEW YORK)

FRANCIS A. L'ESPERANCE, JR., being first duly sworn, hereby deposes and states:

(1) that he is the inventor of the invention of Patent No. 4,718,418 and signed the small-entity statement filed October 8, 1986, in the file wrapper of said Patent;

(2) that on signing said small-entity statement, the facts recited therein were true;

(3) that as of April 21, 1987, and for a substantial period of time beyond issue of said Patent, he was unaware and was not advised that conclusion of a license agreement on that date had had any effect on the small-entity status of the subject matter of the above-captioned patent; moreover, as of April 21, 1987 all responsibility for payment of fees for my cornea-sculpture cases had been transferred to and assumed by Taunton Technologies, Inc.;

(4) that he has since learned of error, in failure to make issue-fee payment on a large-entity basis, through counsel other than Mr. Hopgood, the attorney of record in preparation and filing of the application which matured into said Patent; and

(5) that he has read the foregoing document entitled "Verified Statement of Facts Pertaining to Payment of Fees" and that the facts recited therein are true, to his best knowledge and belief.

Francis A. L'Esperance, Jr.
Francis A. L'Esperance, Jr.

SUBSCRIBED and sworn to before me this 15 day of April, 1991.

Colleen A. Latella
Notary Public

(Seal)

COLLEEN A. LATELLA
Notary Public, State of New York
No. 31-9308886
Qualified in New York County
Commission Expires February 28, 1993

VERIFICATION OF WILLIAM B. TELFAIR

WILLIAM B. TELFAIR, hereby declares:

(1) that he was continuously since its founding in 1986 and through November 26, 1990, Vice President of Taunton Technologies, Inc.;

(2) that said corporation was formed to develop laser-sculpture inventions of Dr. Francis A. L'Esperance, Jr., said inventions being assigned to LRI L.P., a Delaware Limited Partnership, the assignee of record in the prosecution which matured into Patent No. 4,718,418;

(3) that long after issue of said patent, he learned through counsel other than Mr. Hopgood, attorney of record, that error occurred, in failure to make issue-fee payment for said patent on a large-entity basis; and

(4) that he has read the foregoing document entitled "Verified Statement of Facts Pertaining to Payment of Fees", as well as the accompanying verification of Dr. Francis A. L'Esperance, Jr., and that the facts therein stated are true, to his best knowledge and belief.

(5) that he declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of said patent.



William B. Telfair

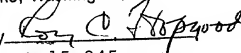
April 13, 1991

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04/15/91

(Date)

By



Reg. No. 15,245

Firm Name

Hopgood, Calimafde, et al.

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04/15/91
(Date)

By Ray C. Hopgood
Reg. No. 15,245

Firm Name Hopgood, Calimafde, et al.



Current
PATENTS/6083

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

***** OFFICE OF INVENTION

U.S. Patent No.: 4,718,418

Issued: January 12, 1988

Applicant: FRANCIS A. L'ESPERANCE, JR.

Serial No.: 916,646

Filed: October 8, 1986

Group: 335

Examiner: David Shay

For: NOV 10 1992 APPARATUS FOR OPHTHALMOLOGICAL SURGERY

GROUP 220

New York, New York 10165
April 15, 1991

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OCT 25 1992

APPLICATION DIVISION-403

REQUEST FOR REFUND OF OVERPAID FEES

The Commissioner of Patents and Trademarks
Washington, D. C. 20231

Attention: Finance Branch

Sir:

Attached is a copy of an undated letter (received by our firm February 19, 1991) under 37 C.F.R. 1.28(c)(2), indicating that a refund of \$467.00 may be requested in the above-entitled matter, via the present separate letter addressed to the Finance Branch.

Also enclosed is a copy of our Verified Statement of Facts Pertaining to Payment of Fees, said Verified Statement being submitted on even date herewith, to the Office of the Assistant Secretary and Commissioner of Patents and Trademarks, and in response to said undated letter.

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20231, on

04/15/91

(Date)

By Ray C. Hopgood
Reg. No. 15,245

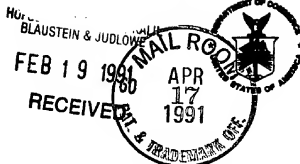
Firm Name Hopgood, Calimafde, et al.

We hereby request payment of the indicated \$467.00
refund to the Office of the undersigned attorney of record
in the above-entitled matter, and/or, in the alternative,
to the undersigned attorney's firm Deposit Account No.
08-2776.

Respectfully submitted,
By Roy C. Hopgood
Roy C. Hopgood
Reg. No. 15,245
Attorney for Applicant/Assignee
212-986-2480

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04/15/91 By Roy C. Hopgood
(Date) Reg.No. 15,245

Firm Name Hopgood, Calimafde, et al.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Hopgood, Calimafde, Kalil,
Blaustein & Judlowe
60 East 42nd Street
New York, NY 10165

In re Application of :
Francis A. L'Esperance, Jr. :
Serial No. 06/916,646 : LETTER UNDER 37 CFR 1.28(c)(2)
Filed: October 8, 1986 :
Patent No. 4,718,418 :
Issued Date: January 12, 1988 :
For: APPARATUS FOR :
OPHTHALMOLOGICAL SURGERY :

This is in response to the paper filed July 10, 1990, under 37 CFR 1.28(c)(2).

Attention is directed to the Notice, Patent and Trademark Office Implementation of 37 CFR 1.28(d) and 1.56(c), (f) and (g), published at 1098 OG 502 on January 3, 1989. A copy of that Notice is attached. The payment of fee deficiencies under 37 CFR 1.28 has been received pursuant to that Notice and small entity status will no longer apply.

The \$807 payment received relates to a deficiency in the Additional claims and issue fees.

As entitlement to small entity status was lost April 21, 1987, only the small entity issue fee was improperly paid as once small entity status was properly established on filing (October 8, 1986 statement date) continued entitlement to small entity status need not be reviewed until payment of the issue fee.

In that fee deficiencies are to be paid at fee levels existing at the time of payment of the deficiency, the issue fee deficiency was \$340.00 and not the \$280.00 submitted leaving a \$60.00 deficiency. A refund of \$467 (\$807 paid - \$340 owed for the issue fee deficiency) may be requested by separate letter to Finance Branch with a copy of the instant Letter). The deficiency payment cannot currently be accepted absent an appropriate verified statement of facts.

37 CFR 1.28(c)(2) requires a verified statement of facts as to how the error occurred and how and when it was discovered by a party with firsthand knowledge thereof (generally an employee of the party who factually asserted entitlement to small entity

status which is rarely patent counsel).

The patent file will be retained for TWO MONTHS from the mail date of this LETTER to allow for the submission of an appropriate verified statement of facts. Any response should be directed to the undersigned at the Special Program Examination Unit, Office of the Assistant Commissioner for Patents, Crystal Park 2, Suite 923.

Karen O. Wood

Karen O. Wood
Legal Technician
Office of the A/C for Patents

Conferee: H. Bernstein *H.B.*

Attachment: OG Notice